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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,512	12/05/2001	Gary Wayne Dunlavy	ADAPP202	6439

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TA, THO DAC

ART UNIT	PAPER NUMBER
	2833

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	10/010,512	DUNLAVY, GARY WAYNE
	Examiner Tho D. Ta	Art Unit 2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM

#### THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 7, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Batten, Jr. et al. (6,097,613).

In regard to claim 1, Batten, Jr. et al. discloses a cable terminator, comprising: a printed circuit board 12 having termination circuitry; a ribbon cable 32 having a first end and a second end, the first end being electrically connected to the printed circuit board 12 to enable termination at the first end; and an encapsulating overmold 16 enclosing the printed circuit board 12 and the first end of the ribbon cable 32.

In regard to claims 2, 3, 7, it has been held that a recitation (e.g., SCSI cable, LVD cable, SCSI controller) with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regard to claim 4, Batten, Jr. et al. discloses that the printed circuit board 30 is electrically passive.

In regard to claim 6, Batten, Jr. et al. discloses that the second end of the ribbon cable 32 connects to a device 42.

In regard to claim 9, Batten, Jr. et al. discloses that the encapsulating overmold 16 is configured to cover the electrical connection between the first end of the ribbon cable 32 and the printed circuit board 12.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5, 10-12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanada et al. (6,442,027).

In regard to claim 1, Sanada et al. discloses a cable terminator, comprising: a printed circuit board 20 having termination circuitry; a ribbon cable 4 having a first end and a second end, the first end being electrically connected to the printed circuit board 20 to enable termination at the first end; and an encapsulating mold 7 enclosing the printed circuit board 20 and the first end of the ribbon cable 4.

In regard to claim 5, Sanada et al. discloses that the printed circuit board 20 has a board width that approximates a ribbon width of the ribbon cable 4.

In regard to claim 10, Sanada et al. discloses a cable having an integrated terminator, comprising: a ribbon cable 4 having a first end, a second end, and at least one device connector 32a between the first end and the second end of the cable 4; a printed circuit board 30 having termination circuitry, the termination circuitry being electrically coupled to the first end of the cable 4; and an overmold 7 sealing the printed circuit board 30 and the first end of the cable 4, the overmold 7 retaining a single output path for the cable 4 that extends to the second end. (The meaning of "overmold" is not clearly set forth in the claim and is thus deemed to be so broad that it is met by the applied reference as a housing or a cover).

The recitation that the cable is SCSI cable has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

In regard to claim 11, Sanada et al. discloses that the printed circuit board 30 is electrically passive.

In regard to claim 12, Sanada et al. discloses that the second end of the ribbon cable 4 connects to a device 20.

In regard to claim 14, Sanada et al. discloses that the overmold 7 is configured a slim and aerodynamic profile to seal the first end of the cable 4 and the PCB 30.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batten, Jr. et al. in view of Sanada et al. (6,442,027).

In regard to claim 10, Batten, Jr. et al. discloses a cable having an integrated terminator, comprising: a ribbon cable 32 having a first end, a second end; a printed circuit board 12 having termination circuitry, the termination circuitry being electrically coupled to the first end of the cable 32; and an overmold 16 sealing the printed circuit board 32 and the first end of the cable 32, the overmold 16 retaining a single output path for the cable 32 that extends to the second end.

However, Batten, Jr. et al. does not disclose that at least one device connector between the first end and the second end of the cable 32.

Sanada et al. discloses at least one device connector 32a (fig. 5A) between the first end and the second end of the cable 4 for providing additional connection.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Batten, Jr. et al. invention by adding an additional connector between the first end and the second end of cable 32 in order to make the cable 32 versatile.

The recitation that the cable is SCSI cable has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

In regard to claim 13 Batten, Jr. et al. does not disclose that the encapsulating dielectric mold is rubberized plastic.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Batten, Jr. et al. invention by constructing the connector housing of a rubberized plastic material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416 (CCPA 1960).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Batten, Jr. et al.

In regard to claim 8 Batten, Jr. et al. does not disclose that the encapsulating dielectric mold is rubberized plastic.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Batten, Jr. et al. invention by constructing the connector housing of a rubberized plastic material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416 (CCPA 1960).

***Response to Arguments***

8. Applicant's arguments filed 06/30/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an overmold is formed by inserting a terminating circuit board with attached cable into a forming mold, and injecting desired overmold material to form the overmold) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Batten, Jr. et al. do not teach or suggest termination circuitry, or that the ribbon cable is connected to the printed circuit board to enable termination, contrary to applicant's argument, fig. 1 clearly shows that the ribbon cable is connected to the printed circuit board by termination at the connector 14.

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In response to applicant's argument regarding claim 11, applicant's disagreement without an explanation is not a proper response.

In response to applicant's argument regarding claim 14, applicant is reminded that the drawing is not to scale. Further, applicant has not clearly recited any sizes or dimensions which can be considered as a slim profile.

In response to applicant's arguments (page 10, paragraphs 2 and 3) against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (703) 308-0800. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

  
THO D. TA  
PRIMARY EXAMINER

tdt  
September 20, 2003